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**MAY 16 2007**

**OFFICE OF PETITIONS**

In re Application of :  
Nicholls et al. : DECISION ON PETITION  
Application No. 09/315,680 :  
Filed: 20 May, 1999 :  
Atty Docket No. 7210-000001/ :

This is a decision on the petition filed on 13 February, 2007, under 37 CFR 1.183 seeking waiver of 37 CFR §§ 1.67 and 1.175 where it requires that a supplemental declaration be executed by a named inventor.<sup>1</sup>

The petition is before the Office of Patent Legal Administration for decision.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. **FAILURE TO TIMELY RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.183."

REVIEW OF FACTS

1. On 20 May, 1999, the application was filed as an application for reissue of U.S. Patent No. 5,631,827.
2. On 25 August, 2006, an Office communication was mailed, requiring a supplemental reissue declaration. A one (1) month shortened statutory period for reply was set.

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<sup>1</sup> Once an application has received a fully executed oath or declaration and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather, the remedy for treating an inventor's refusal to also sign a supplemental oath or declaration is waiver of 37 CFR 1.67. See MPEP 603.

3. On 9 October, 2006, a response consisting of an amendment and a petition for a one (1) month extension of time were filed. No supplemental reissue declaration was filed on 9 October, 2006.

4. On 13 February, 2007, the present petition was filed, along with a supplemental reissue declaration naming Peter Nicholls, Robert Kinyon, Jeff Skaistis, Steve Johnson, Andy Locker, Chris Guzik, and Scott Howard, as joint inventors. The supplemental reissue declaration was signed by all inventors except joint inventors Nicholls and Johnson. Petitioners assert joint inventors Nicholls and Johnson could not be located or refused to sign the supplemental reissue declaration.

DECISION ON PETITION UNDER 37 CFR 1.183  
TO WAIVE §§ 1.67 AND 1.175

Petitioners state that letters were sent to joint inventors Nicholls and Johnson asking them to confirm that they were former employees of the assignee's and informing them that the current assignee had documents for their review. The letters were sent to the last known addresses of each inventor using United Parcel Service (UPS). A copy of the UPS Package Tracking report was provided for the letters sent to each inventor. The UPS tracking report shows that the letter to Johnson was delivered. No response, however, was received from Johnson. The UPS tracking report for the letter sent to Nicholls indicates that no delivery was made, and that Nicholls had moved to a different address.

Suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires." The facts presented on the record do not adequately establish an extraordinary situation. Petitioners have not sufficiently established any special circumstances of equities that would require suspension of the rules in the interests of justice.

This application bears an original Declaration executed by the two non-signing joint inventors, Nicholls and Johnson. Thus, the provisions of 37 CFR 1.47 do not apply in this instance. Nevertheless, it is appropriate to apply the principles for a showing under 37 CFR 1.47 to the situation at hand.

Petitioners' showing is deficient in that proof of diligent efforts to locate non-signing inventor Nicholls has not been made.<sup>2</sup>

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<sup>2</sup> MPEP 409.03(d).

Specifically, petitioners have not shown that diligent efforts were made to locate Nicholls. It is noted that Nicholls' last known address is in Belgium. If any inventor no longer lives at the last known address, petitioners may show diligent efforts by use of a national registry or other database to determine a current address for the non-signing inventor. If a more recent address is discovered, petitioners should send or give a copy of the application papers to the inventor at that address.

Moreover, the declaration is defective in that no residence or mailing address in accordance with 37 CFR 1.175 and 1.63 has been provided for joint inventor Nicholls. A new declaration in accordance with 37 CFR 1.175 and 1.63 signed by all of the signing inventors on behalf of themselves and the non-signing inventor must be provided.

#### CONCLUSION

1. The petition is dismissed.
2. As the Office communication mailed on 25 August, 2006, set a one (1) month shortened statutory period for reply, and the present petition and declaration were filed on 13 February, 2007, a five (5) month extension of time is required to make the petition a timely reply. The extension of time fee will be charged to counsel's deposit account as authorized in the petition.
3. Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX: (571)273-8300  
Attn: Office of Petitions

By hand: Customer Service Window  
Mail Stop Petition  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

4. Telephone inquiries related to this decision only should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

5. Inquiries regarding petition status or general petition information are handled by the Office of Petitions staff at (571) 272-9282.

A handwritten signature in cursive script, appearing to read "Kenneth M. Schor".

Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy